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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,584	07/13/2007	Kurt Dietliker	II/2-23016/A/PCT	9684
324	7590	11/17/2009	EXAMINER	
JoAnn Villamizar Ciba Corporation/Patent Department 540 White Plains Road P.O. Box 2005 Tarrytown, NY 10591			BERMAN, SUSAN W	
			ART UNIT	PAPER NUMBER
			1796	
			NOTIFICATION DATE	DELIVERY MODE
			11/17/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/587,584	<b>Applicant(s)</b> DIETLIKER ET AL.	
	<b>Examiner</b> /Susan W. Berman/	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 8-12 is/are pending in the application.
- 4a) Of the above claim(s) 11-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                     |                                                                   |
|-------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                         | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 1796

***Election/Restrictions***

Applicant's election with traverse of Group in the reply filed on 08-18-2009 is acknowledged. The traversal is on the ground(s) that the amended claims are not disclosed by Berner et al so provide a special technical feature and unity of invention. This is not found persuasive because species of the photoinitiator wherein R<sub>30</sub> is "H" in the amended claims are disclosed by the prior art references cited herein below. Therefore, the instantly claimed photoinitiators do not provide a special technical feature linking the invention of claims 11-12 with the claims 1-5 and 8-10. Upon reconsideration claim 10, drawn to a method of using the photoinitiator of claim 1, has been rejoined with claims 1-5, 8 and 9.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 and 8-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The definition of R<sub>31</sub> in claim 1 is confusing because of the use of commas, semi-colons and "or". It is not clear which groups are unsubstituted and which groups are substituted. It is suggested that applicant use semi-colons to separate the different moieties, such as "hydrogen; C<sub>1</sub>-C<sub>18</sub>-alkyl; C<sub>1</sub>-C<sub>18</sub>-alkyl substituted by hydroxy, alkoxy,...and/or -COO(C<sub>1</sub>-C<sub>4</sub>-alkyl); C<sub>3</sub>-C<sub>18</sub>-alkenyl; ...".

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Eldin et al (6,048,667). Eldin et al disclose heterogeneous photoinitiators of formula (I) in column 3, lines 57-61, wherein the "Phot" radical can be derived from  $\alpha$ -aminoalkylphenones of formula (V) in column 7, lines 1-46. In formula (V),  $R_{16}$  can be  $-NHR_2$  or  $C_2-C_6$ hydroxyalkyl- $NR_2$ - wherein  $R_2$  is H,  $C_{1-12}$ alkyl,  $C_5$  or  $C_6$  cycloalkylenemethyl or -ethyl, phenyl, benzyl or 1-phenyleth-2-yl. Eldin et al specifically disclose photoinitiators such as 2-methyl-1-[4-(hydroxyethylamino)phenyl]-2-dimethylamino-propan-2-one in column 7, lines 41-42 and methyl-1-[4-(hydroxyethylamino)phenyl]-2-morpholino-propan-2-one in column 7, lines 45-46. These two species, at least, correspond to compounds of the formula set forth in the instant claims.

Claims 1-5 and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Kojima (5,698,285). Kojima discloses  $\alpha$ -aminoacetophenone compounds (C) of the formula shown in column 5, lines 15-25. Compounds wherein  $X_1$  is an allyl group and wherein  $X_{5-9}$  can be H or  $-N(X_{19})(X_{20})$  among other substituents disclosed in column 6, line 61 to column 8, line 9. Kojima discloses that  $X_{19}$  or  $X_{20}$  can independently be a hydrogen or a hydroxyalkyl group, etc. (column 7, line 53, to column 8, line 5).

Claims 1-5 and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Desobry et al (5,554,663). Desobry et al disclose  $\alpha$ -aminoacetophenone compounds of formula I wherein  $Ar^1$  can be formula (IV) shown in column 2, lines 1-8.  $R^{5-9}$  in formula IV can be  $-N(X^{20})(X^{21})$  in

Art Unit: 1796

which R<sup>20</sup> or R<sup>21</sup> can independently be hydrogen or C<sub>2-4</sub>hydroxyalkyl, C<sub>2-10</sub>alkoxyalkyl, etc. (column 3, lines 29-30, and column 4, lines 9-16).

*Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kohler et al (5,532,113) disclose photoinitiating compounds containing reactive groups that can be further reacted to provide multifunctional photoinitiators.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Susan W. Berman/ whose telephone number is 571 272 1067. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571 272 1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SB  
11/9/2009

/Susan W Berman/  
Primary Examiner  
Art Unit 1796